

## REMARKS

Reconsideration and allowance of this application are respectfully requested in light of the above amendments and the following remarks.

The Applicants acknowledge with appreciation the indication in the Office Action that claims 28-37 and 40 are allowed.

Claims 51-53 stand withdrawn as being directed to non-elected subject matter.

Claims 41-45 and 47-50 have been amended for clarity. The amendments are considered to be non-narrowing; therefore, no estoppel should be deemed to attach thereto.

Claims 42-50 stand objected to for failing to further limit the subject matter of base claim 41. More specifically, the Office Action proposes that claims 42-50 are objectionable because they only recite functional limitations that do not impart structural limitations (see paragraph bridging pages 4 and 5, paragraph bridging page 5 and 6, and page 6, second paragraph).

Claims 41-50 stand rejected as being indefinite for failing to sufficiently recite structural elements (see page 6, second to last paragraph). Claims 41-50 also stand rejected, under 35 USC § 102(b), as being anticipated by Wolf (US 5,983,383).

The Applicants respectfully traverse the applied objections and rejections based on the points set forth below.

### I. Objections and Indefiniteness Rejections

In the Amendment filed April 21, 2008, the Applicants traversed the objections and indefiniteness rejections applied in the Final Rejection, dated February 20, 2008, which applied the same bases for the objections and indefiniteness rejections now applied in the Office Action.

Applicants incorporate by reference the remarks from the Amendment traversing the objections and indefiniteness rejections.

A. Structural Limitations Imparted by Functional Language

In response to Applicants' previous traversal, the Office Action proposes that unless recited functional language imparts some structural limitation on a claimed apparatus, the functional language cannot be regarded as distinguishing over the prior art (see Office Action page 3, third paragraph). The Office Action cites *Venezia* for the proposition that functional limitations which require physical alterations of a structure satisfy 35 USC 112, second paragraph because the altered structure is structurally different from the unaltered structure (see Office Action page 3, lines 1-6 of last paragraph; and *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976)). The Office Action takes the position that Applicants' functional language does not impart structural limitations to the claimed subject matter.

However, Applicants' claim 41 defines a mobile station having a transmitter that transmits a data packet using a hybrid automatic repeat request (HARQ) retransmission protocol and synchronous retransmissions. Thus, as imparted by the functional language, the transmitter of the mobile station defined by claim 41 necessarily has the structural limitations required to transmit using a HARQ retransmission protocol and to transmit synchronous retransmissions. These structural limitations distinguish the recited transmitter from transmitters that do not transmit using a HARQ retransmission protocol and synchronous retransmissions.

Claim 41 further recites a processing unit that determines whether the transmission power required for synchronously transmitting a retransmission data packet and other uplink data is less than a maximum allowed power. Thus, as imparted by the functional language, the processing

unit of the mobile station defined by claim 41 necessarily has the structural limitations required to determine whether the transmission power required for synchronously transmitting a retransmission data packet and other uplink data is less than a maximum allowed power. This structural limitation distinguishes the processing unit from processing units that do not determine whether the transmission power required for synchronously transmitting a retransmission data packet and other uplink data is less than a maximum allowed power.

Claim 41 further recites a receiver that is similarly structurally defined by functional language. And this functional language imparts structural limitations the receiver must have to achieve the functional limitations and that distinguish the receiver from receivers that do not achieve the functional limitations.

Thus, just as the Office Action proposes that *Venezia's* claimed sleeve adapted to be fitted over a cable is functional language that structurally limits the claim because this language distinguishes the claimed sleeve from one that is not so fitted, so too does Applicants' functional language structurally limit the claimed mobile terminal (see Office Action page 5, lines 1-6 of second paragraph). No relevant difference exists between the manner in which *Venezia's* functional language limits the structure of the claim and the manner by which Applicants' functional language limits claim 41.

As stated by the CCPA, "[w]e see nothing wrong in defining the structures of the components ... in terms of the interrelationship of the components, or the attributes they must possess" (see 152). Applicants' claim 41 defines the recited components of the transmitter, receiver, and processing unit in terms of the attributes they must possess, and the CCPA has found nothing wrong with defining components of a claimed apparatus in this way.

Accordingly, the Office Action's proposal that the functional language recited in claim 41 does not impart structural limitations is unfounded. Claims 42-50 similarly recite functional language that imparts structural limitations.

#### B. Additional Structural Elements

The Office Action asserts that claim 41 does not recite any structural element and/or cooperative relationships to the recited structural elements of the transmitter, receiver, and processing unit for implementing the functional limitations mentioned above (see paragraph bridging pages 6 and 7).

However, the Office Action's assertion is not a premise for objecting to or rejecting the claims. The assertion is based on claim scope rather than claim definiteness.

Claim 41 recites a transmitter, receiver, and processing unit that perform specific functions and, thus, necessarily incorporate the structural features required to accomplish the recited functions. The Office Action does not propose that the recited functions cannot be understood, as required to support an indefiniteness rejection and an indefiniteness-based objection; instead, the Office Action proposes that the claims are indefinite due to their broad scope (i.e., due to their failure to identify a specific structure for achieving the recited functions).

Breadth of a claim is not to be equated with indefiniteness (see MPEP § 2173.04, lines 1-2; and *In re Miller* 441 F.2d 689, 169 USPQ 597 (CCPA 1971)). If the scope of the subject matter embraced by the claims is clear, then the claims comply with 35 USC 112, second paragraph (see MPEP § 2173.04, second sentence).

In the present circumstance, the Office Action neither proposes that the structural elements of the recited transmitter, receiver, and processing unit are unclear or that the functions

performed by these elements are unclear. Instead, the Office Action proposes that the specific structure for achieving the recited functions must be claimed, by identifying the distinguishing structural elements of this specific structure. However, identifying the specific species of structures within a genus of structures that may achieve the recited functions is a matter of claim breadth, not claim definiteness.

Accordingly, the Office Action's basis for rejecting claim 41 for indefiniteness due to its broad claim scope is unfounded. The objections and indefiniteness rejections applied to claims 42-50 are similarly unfounded.

#### C. Programmable Logic Implementation

The Office Action proposes that claims 41-50 are indefinite because the functions recited in the claims can be implemented by programmable logic and software (see Office Action, sentence bridging pages 3 and 4). However, the assertion that claimed functions can be implemented by programmable logic and software is not a basis for an indefiniteness rejection or objection. As discussed in section I(B), above, the proposal that claimed functions can be implemented by programmable logic and software is drawn to claim breadth, not claim definiteness.

#### D. 35 USC 112, Second Paragraph Requirement for Distinguishing Limitation

The Office Action proposes that 35 USC 112, second paragraph requires a claim to recite a limitation that distinguishes claimed subject matter from the prior art (see Office Action page 4, lines 1-3). However, 35 USC 112, second paragraph does not require a claim to distinguish over the prior art; instead, 35 USC 102 and 103 require claimed subject matter to distinguish

over the prior art. Accordingly, this basis for the indefiniteness objections and rejections is unfounded.

#### E. Functional Matter Not Associated with Structural Elements

The Office Action proposes that the functional language of claims 41-50 does not clearly impart a structural relationship with the recited structural elements (see Office Action page 4, lines 4-7).

However, as discussed in section I(A), claim 41 defines a mobile station having a transmitter that transmits a data packet using a HARQ retransmission protocol and synchronous retransmissions. The functional language relates to the transmission, and the relationship of a transmission to a transmitter would be clear to a skilled artisan; specifically, a skilled artisan would recognize that a transmitter transmits. Moreover, based upon Applicants' disclosure in the specification, a skilled artisan would understand how the functional limitation of transmitting a data packet using a HARQ retransmission protocol would further structurally limit the transmitter so as to achieve the functional limitation. Also, a skilled artisan would understand how the functional limitation of transmitting synchronous retransmissions would structurally limit the transmitter so as to achieve the functional limitation. A skilled artisan would similarly understand how the functional limitations related to the receiver and processing unit would limit the structures of these components.

Moreover, the Office Action tacitly acknowledges that a skilled artisan would understand how the functional limitations limit the structures of the transmitter, receiver, and processing unit by stating that a person would be capable of developing a programmable logic that performs the claimed functionality (see Office Action, sentence bridging pages 3 and 4). If a skilled artisan

could not determine how the functional limitations recited in claim 41 limited the structure of the claimed mobile terminal, as would be necessary to support an indefiniteness rejection, then it necessarily follows that the artisan could not develop a programmable logic to perform the functionality.

Accordingly, the Office Action's acknowledgement that a person could implement the claimed subject matter belies the assertion that the recited functional language does not clearly define the structural limitations of the claimed subject matter. The indefiniteness objections and rejections applied to claims 42-50 are similarly unfounded.

F. *Hewlett-Packard Co. v. Bausch & Lomb Inc.*

The Office Action cites *Hewlett-Packard* for the proposition that claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function, because apparatus claims cover what a device is, rather than what a device does (see Office Action page 3, second paragraph; and *Hewlett-Packard Co. v. Bausch & Lomb Inc.* 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990)).

However, in *Hewlett-Packard*, the Federal Circuit was stating the principle that a claimed device could distinguish over a prior art device that performs the same operation if the two devices have different structures (see *Hewlett-Packard Co. v. Bausch & Lomb Inc.* 1528). The Office Action has taken the Federal Circuit's statement -- apparatus claims cover what a device is, rather than what a device does -- out of the 35 USC 102/103 context in which it was made and misconstrued the statement within the context of an indefiniteness rejection.

Whether claimed subject matter performs the same operation or has the same structure as a prior art device has no bearing on the issue of the claim's definiteness under 35 USC 112,

second paragraph. And as acknowledged in the Office Action, functional language is capable of imparting structural limitations on an apparatus (see Office Action page 3, third paragraph).

G. In Re Venezia

The Office Action cites *Venezia* in support of its indefiniteness objections and rejections without identifying how the facts within *Venezia* relate to Applicants claimed subject matter so as to support the indefiniteness objections and rejections (see Office Action page 3, last paragraph). In *Venezia*, the CCPA differentiated functional language directed toward limiting the structure of an apparatus from functional language that identified a future use of a claimed apparatus (see *Venezia* 151-152).

The Office Action does not propose that the functional language in Applicants' claims is directed toward a future use of the claimed subject matter. Thus, in the context of *Venezia*, the only other type of functional language is that which limits the structure of a claimed apparatus, which the Office Action seems to tacitly acknowledge (by the citation of *Venezia* and the failure to propose that Applicants' functional language is directed toward a future use of the claimed subject matter) is the type of functional language within Applicants' claims.

Applicants respectfully submit that the Office Action bases the indefiniteness objections and rejections on platitudes rather than findings of fact as to how Applicants' functional language differs from that within *Venezia's* claims so as to support an inference that a different outcome is warranted for Applicants' claims than occurred in relation to the indefiniteness rejections applied to *Venezia's* claims.



## H. Summary

Accordingly, the Office Action's proposal that the functional language recited in claim 41 does not impart structural limitations is unfounded. Claims 42-50 similarly recite functional language that imparts structural limitations. Therefore, withdrawal of the indefiniteness objections and rejections applied to claims 41-50 is warranted.

## II. Anticipation Rejections

The Office Action cites Wolf only for disclosing the limitations recited in claim 41 of a transmitter, a receiver, and a processing unit (see Office Action page 10, lines 1-3). The Office Action tacitly acknowledges that Wolf does not disclose the structural limitations defined by the functional language within claim 41 by its proposal that the functional language does not impart structural limitations that must be found within the prior art to support an anticipation rejection (see page 10, second paragraph, through page 11, third paragraph).

For the reasons discussed in section I, above, the functional language of claims 41-50 does impart structural limitations on the claimed mobile terminal. Accordingly, the Office Action has not established a *prima facie* showing that Wolf anticipates the subject matter of claims 41-50.

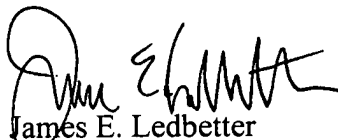
For example, Applicants claim 41 defines a mobile station having: (1) a transmitter that transmits a data packet using a HARQ retransmission protocol and synchronous retransmissions, (2) a receiver that receives a HARQ feedback message, and (3) a processing unit that determines whether the transmission power required for synchronously transmitting a retransmission data packet and other uplink data is less than a maximum allowed power. The Office Action does not propose that Wolf discloses any of these structural features.

Accordingly, the Applicants submit that Wolf does not anticipate the subject matter defined by claim 41. Therefore, allowance of claim 41 and all claims dependent therefrom is warranted.

In view of the above, it is submitted that this application is in condition for allowance, and a notice to that effect is respectfully solicited.

If any issues remain which may best be resolved through a telephone communication, the Examiner is requested to telephone the undersigned at the local Washington, D.C. telephone number listed below.

Respectfully submitted,



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